

REMARKS/ARGUMENTS

Claims 1-9 are pending in the application. Claims 1-7 are allowed. The Applicants have amended claim 8. Reconsideration and allowance of claims 8-9 is respectfully requested.

The Applicants acknowledge with thanks the allowance of claims 1-7.

On page 2 of the Office Action claim 8 stands rejected under 35 USC § 112, first and second paragraphs. In view of the foregoing amendment to claim 8 the rejections thereof are overcome. Applicants request the rejections of claim 8 be withdrawn.

On page 2 of the Office Action claim 9 stands rejected under 35 USC § 112, first paragraph, as not enabled. Applicants respectfully traverse this rejection.

The Applicants submit that one skilled in the art could make and use the claimed invention of claim 9 without undue experimentation. In particular, the Applicants respectfully submit that, having enabled both the making of the claimed compounds and the testing of the claimed compounds for DPP-IV inhibition, one skilled in the art could make and use the claimed compounds to treat type-1 diabetes without undue experimentation.

Given the test showing that the claimed compounds are inhibitors of DPP-IV, a working example of the claimed compounds treating type-1 diabetes is not necessary for one skilled in the art to make and use the claimed invention without undue experimentation. One skilled in the art, *e.g.*, an endocrinologist, would know how a demonstrated DPP-IV inhibitor could be used to treat type-1 diabetes. Symptoms of type-1 diabetes will be manifest sometime before a patient's insulin-producing pancreatic islets are totally destroyed and the patient will continue to produce insulin until the disease destroys all the patient's pancreatic islets. At least in this transition period between diagnosis and absolute insulin deficiency, it would be apparent to a skilled artisan that a DPP-IV inhibitor can be used to treat type-1 diabetes by promoting an increased serum insulin level.

Moreover, Applicants respectfully submit that lack of treatment options does not equate to a non-existent skill level in the art. One skilled in the art, *e.g.*, an endocrinologist, would be highly educated and quite familiar with the pathology and treatment of type-1 diabetes, which is to say that one skilled in the art could readily understand how to use a demonstrated DPP-IV inhibitor to treat type-1 diabetes.

Based on the foregoing, Applicants submit that claim 9 is enabled, therefore the rejection is overcome. Applicants request the rejection be withdrawn.

In view of the foregoing, the Applicants submit that all claims are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issuance are earnestly solicited. Included herewith are the appropriate fees for a RCE and petition for three-month extension of time. In the event that there are any fees dues and owing in connection with this matter, please charge the same to our Deposit Account No. 11-0223.

Respectfully submitted,

Dated: January 10, 2008

By: s/Timothy X. Gibson/

Timothy X. Gibson

(Reg. No. 40,618)

Attorney for Applicant(s)

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT 06877
Tel.: (203) 798-4868